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EXAMINER

TSIDULKO, MARK

ART UNIT

PAPER NUMBER

2875

DATE MAILED: 04/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/931,221

Applicant(s)

CHAO, DAVID

Examiner

Mark Tsidulko

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,10-14,19-21,25 and 26 is/are rejected.
- 7) ☒ Claim(s) 3,7-9,15-18,22-24 and 27-30 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. The submission of the amendment filed on 1/21/03 is acknowledged. At this point claims 1, 11, 19 have been amended and remaining claims left unchanged. Thus, claims 1-30 are at issue in the instant application.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims **1, 10** are rejected under 35 U.S.C. 102(b) as being anticipated by Price (U.S. 4,234,910).

2. Referring to Claim **1** Price discloses (Figs. 2, 5) an eyeglasses having a front frame [20], arms [22] extending therefrom and a light source [14] and [22] positioned at an end of the arms.

3. Referring to Claim **10** Price discloses (Fig. 2) eyeglasses wherein a light source [22] is positioned to shine towards the proximal end of the arm.

Claims **11-14** are rejected under 35 U.S.C. 102(b) as being anticipated by Colitz (U.S. 5,430,503).

4. Referring to Claim **11** Colitz discloses (Figs. 2, 5) an eyeglasses having a front frame portion and arms [12] extending therefrom and a discrete writing instrument stored on the arm.

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5. Referring to Claim **12** Colitz discloses (Fig.5) the arm provided with an opening [18] into a cavity [22] in the arm, the cavity is shaped to receive a writing instrument.

6. Referring to Claims **13, 14** Colitz discloses (Fig.5) the arm wherein the opening [18] is provided at the distal end of the arm [12].

Claims **19-21, 25, 26** are rejected under 35 U.S.C. 102(a) as being anticipated by Mechlin (U.S. 6,286,954).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Referring to Claim **19** Mechlin discloses (Figs.1, 3) an eyeglasses having a front frame portion, arms [26] extending therefrom and a discrete screwdriver stored on the arm.

8. Referring to Claim **20** and claims **25, 26** (as best understood) Mechlin discloses (Fig.3) an eyeglasses wherein the arm [26] is provided with an opening into a cavity in the arm, the cavity being shaped to receive a screwdriver, wherein the screwdriver is stored and faces towards a distal end.

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9. Referring to Claim 21 Mechlin shows (Fig.3) the screwdriver is attached to a plug end [42].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 2, 4, 5, 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Price (U.S. 4,234,910).

It would have been obvious that the light source may be at any desired place of arm surface depending on necessity.

Allowable Subject Matter

Claims 3, 7, 8, 9, 15-18, 22-24, 27-30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

11. Referring to Claim 3 the prior art of record fails to show a light source that is positioned at a distal end of the arm.
12. Referring to Claim 7 the prior art of record fails to show a light source that is positioned in a recess of the arm.

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13. Referring to Claim **8** the prior art of record fails to show a light source that is positioned in a cavity within the arm.
14. Referring to Claim **9** the prior art of record fails to show a light source that is positioned to shine towards the distal end of the arm.
15. Referring to Claims **15, 24** the prior art of record fails to show the eyeglasses wherein a side of the arm is provided with a groove that opens into the cavity.
16. Referring to Claim **16** the prior art of record fails to show the eyeglasses having the combination of the light source and a container for storing the writing instrument.
17. Claim **17** is objected to as being dependent upon a rejected base claim 16, but would be allowable if claim 16 will be rewritten in independent form.
18. Claim **18** is objected to as being dependent upon a rejected base claim 17, but would be allowable if claim 16 will be rewritten in independent form.
19. Referring to Claim **22** the prior art of record fails to show the eyeglasses wherein the screwdriver extends from the distal end of the arm.
20. Claim **23** is objected to as being dependent upon a rejected base claim 22, but would be allowable if claim 22 will be rewritten in independent form.
21. Referring to Claim **27** the prior art of record fails to show that the opening of the container faces towards a proximal end of the arm.
22. Referring to Claim **28** the prior art of record fails to show an eyeglasses having light source and at least one reversible arm.
23. Referring to Claim **29** the prior art of record fails to show an eyeglasses having writing instrument and at least one reversible arm.

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24. Referring to Claim **30** the prior art of record fails to show an eyeglasses having a screwdriver and at least one reversible arm.

Response to Arguments

Applicant's arguments filed on 1/21/03 have been fully considered but they are not persuasive.

25. Applicant argue that the teachings of Colitz and Mechlin are deficient with respect to the embodiments disclosed and claimed by Applicant. However Applicant needs to specifically point out the deficiency (see MPEP 716.01(c)).

In response, the Examiner would like to direct the Applicant's attention to the facts that these references include all claimed limitations. Colitz discloses writing instrument which is discrete because is separate from arm [12]. Mechlin discloses a screwdriver which is discrete because also is separate from arm [12].

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Tsidulko whose telephone number is (703)308-1326. The examiner can normally be reached on 8 - 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on (703) 305-4939. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9318 for regular communications and (703) 872-9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

M.T.
March 24, 2003


Sandra O'Shea
Supervisory Patent Examiner
Technology Center 2800